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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,029	06/07/2006	Mark Edward Huntley	PCT-2006-1	1089
7590 07/31/2008				
Martin E Hsia Cades Schutte A Limited Liability Law Partnership 1000 Bishop Street 12th Floor Honolulu, HI 96813			EXAMINER LILLING, HERBERT J	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 07/31/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/582,029

**Applicant(s)**

HUNTLEY ET AL.

**Examiner**

HERBERT J. LILLING

**Art Unit**

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

Art Unit: 1657

1. Claims 1-19 are present in this application which is a 371 of PCT/US06/22443 filed June 7, 2006 which claims benefit to provisional application US 60688396 filed June 7, 2005.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I, claim(s) 1-15,** drawn to a process employing selecting a species of photosynthetic microbe capable of doubling in biomass in approximately 16 hours or less in the presence of carbon dioxide in an open system which species is grown in a closed system and maintained to obtain a biomass that is inoculated from said closed system to an open system which carbon dioxide is supplied to replace the carbon dioxide removed by the microbes and maintaining the open system to double in biomass within less than 16 hours for a period of less than 5 days which biomass includes feedstock or microbes and stack gas comprising carbon dioxide and fuels to produce oil, classified in Class 435, numerous subclasses which includes 166, 243 and 244.

**Group II, claim(s) 14 -15,** drawn to a process for synthesizing oil, comprising:

the following steps;

a) selecting photosynthetic microbes that double in biomass in approximately 16 hours or less when supplied with sufficient carbon dioxide in an open pond having a carrying capacity;

b) **injecting or dissolving stack gases having carbon dioxide concentrations of at least 3.5% into a photobioreactor having a maximum culture depth of approximately 20 centimeters, wherein said stack gases are selected from the source consisting of burning a fossil fuel, industrial production of chemicals, refining of oil and gas, and geological extraction of fossil fuels;**

c) introducing said microbes into said photobioreactor; providing **said microbes**

Art Unit: 1657

- d) with sufficient nutrients in said photobioreactor to avoid nutrients being a limiting factor to growth;**
- e) turbulent mixing of said microbes throughout said photobioreactor, whereby said microbes undergo continuous exponential growth in said photobioreactor;**
- f) inoculating an initial biomass of said microbes that is no less than 5% of said carrying capacity of said open pond from said closed photobioreactor into said open pond;
- g) supplying carbon dioxide to said open system continuously, to supply sufficient carbon dioxide to said microbes and to replace carbon dioxide removed by said microbes;
- h) maintaining said microbes in said open pond with high nutrient concentrations for at most 5 days,
- i) whereby initial conditions of high light intensity and high nutrient concentrations favor continued exponential growth for a short period,**
- j) but wherein growth becomes limited by nitrogen availability which inhibits protein synthesis, whereby oil content is increased,

classified in Class 435, subclass 173.

Claims 16, 17 and 18 will also be examined with this Invention drawn to the same subclass having similar process steps which requires high light intensity.

**Group III, claim 19**, drawn to a device for cultivating photosynthetic microbes on a land area, classified in Class 435, subclass 292.1.

3. The inventions are independent or distinct, each from the other because the inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1 since Invention I does not require the specifics of Invention II as well as the apparatus does not require the specifics of Inventions I or II.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of **their different classification for each of the above inventions;**
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search which includes searching different classes/subclasses as well as electronic resources which searches employing different search queries that would be extremely burdensome;
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

4. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction

Art Unit: 1657

requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. This application contains claims directed to the following patentably distinct species for Inventions I or II and if Invention III is elected no further election of species is required.

- A. Whereby the process of Invention I is drawn to a process:
- a) for cultivating photosynthetic microbes or synthesizing feedstock;
  - b) for synthesizing oil;
  - c) using stack gas;
  - d) other-please specify;

e) combination of above-please specify.

B. Whereby the process of Invention II is drawn to a process:

- a) for synthesizing or biosynthesizing oil;
- b) for synthesizing biomass or biomass feedstock;
- c) other-please specify;
- d) combination of above-please specify.

Applicant is required to elect either A [and further if A is elected one species from a), b), c), d) or e) ] or B [and further if B is elected one species from a), b), c) or d)]

Thus, there is only one genus A or B and one ultimate species from that genus for examination purposes.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 9, 10, 12 and 13 are generic to Invention I; Claims 14-18

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the

species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.



Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant is required to clearly indicate **(ii) identification of the claims encompassing the elected species for above requirements drawn to the elected invention for examination.**

6. In accordance with this Tech Center Policy based on above restriction containing product claims and process claims, this Examiner will rejoin any non-elected process claims upon the election of a product claim which is subsequently is found allowable in view of the following guidelines:

**F.P.: Ochiai/Brouwer Rejoinder form paragraph**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),"

Art Unit: 1657

1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HERBERT J. LILLING whose telephone number is 571-272-0918. The examiner can normally be reached on WORK AT HOME MAXIFLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JON WEBER can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit **1657**  
July 28, 2008

/HERBERT J LILLING/  
Primary Examiner Art Unit 1657

